

REMARKS

The last Office Action has been carefully considered.

It is noted that claim 9 is rejected under 35 U.S.C. 102(b) over the patent to Muetschele.

Claims 9-12 and 15 are rejected under 35 U.S.C. 102(b) over the patent to Frauhammer.

Claims 13-14 and 16 are rejected under 35 U.S.C. 103(a) over the patent to Frauhammer.

Also, claims 9-16 are rejected under 35 U.S.C. 112.

In connection with the Examiner's rejection of the claims for formal reasons under 35 U.S.C. 112, applicant wishes to make the following remarks.

The Examiner indicated that it was not clear whether claim 1 defined a percussion mechanism or a hand power tool. It is believed that claim 1, as previously amended, should be considered as clearly defining the invention. It is clearly defined in claim 1 that this claim defines a percussion mechanism for a repetitive hammering hand power tool (in the form of a rotary hammer) that has

a striker... etc. It is well known in the art that a percussion mechanism is a mechanism which has a striker and a device exerting a pressure on the striker, and this is what is defined in the first part of the claim. Definitely, the striker as a component is a part of the percussion mechanism of the present invention. However, to be responsive, applicant has somewhat amended claim 9 to repeat the term "the percussion mechanism" as having a striker, a device, ... a blocking element...

It is believed that the amendment to claim 9 does not raise any new issues for examination and/or search after the Final Action, and therefore the present Request for Reconsideration should be entered by the Examiner, and such entry is most respectfully requested.

In his rejection of the claims and in the Examiner's response to arguments, the Examiner indicated that in his opinion the references performed, the same functions as in the claimed invention and disclosed all the recited structural limitation. He further stated that while it was possible that the references may not perform the same function or in the same manner, the claims were not restricted to such devices.

Claim 1 specifically defines that the percussion mechanism is provided with a blocking element with which the striker is blockable in its forward

motion and also which has a controllable blocking time for adjusting a striking frequency of the striker.

It is respectfully submitted that claim 1 does not simply define functioning of a blocking element, but instead defines a structural component of the percussion mechanism in accordance with the present invention, which is configured in a corresponding manner. In particular, in the inventive percussion mechanism the blocking element is configured (structured, arranged, located, ...) so that it blocks the striker in its forward motion, and its blocking time is controlled. This is clearly a structural limitation which is presented substantially in a means-plus-function form.

Claim 1 does not define simply a blocking element of a percussion mechanism, but instead it defines such a blocking element mechanism which blocks a forward motion on the striker and has a controllable blocking time.

The references applied by the Examiner against the original claims did not teach the above mentioned new features of the present invention.

The shaft portion 47 disclosed in the Muetschele reference and identified by the Examiner as a blocking element is not configured as a blocking element which blocks the striker in its forward motion, since it can not and does not block the forward motion of the striker 17. Thus, it is believed to be clear that

this reference does not teach the new feature of the present invention that the percussion mechanism is provided with a blocking element that blocks the striker in its forward motion.

In the patent to Frauhammer the striker 17 can not contact the blocking elements 23, 31 under any circumstances as can be seen from Figure 1, since its progress toward contacting the blocking elements 23, 31 is obstructed by the riveting die 18, similarly to the situation in the Muetschele reference. Thus, this reference also does not teach the new features of the present invention as defined in claim 1.

The claims were rejected over the Muetschele and Frauhammer references under 35 U.S.C. 102(b) as being anticipated. In connection with this it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the references do not disclose each and every element of the percussion mechanism of the present invention as now defined in claim 9.

It is therefore believed that the anticipation rejection of claim 9 under 35 U.S.C. 102(b) over the references should be considered as not tenable and should be withdrawn.

As for the obviousness rejection applied by the Examiner against some dependent claims under 35 U.S.C. 103(a), this rejection is not applicable with respect to claim 9 as well. The references do not contain any hint or suggestion for the above specified features which are now defined in claim 9. Therefore, it can not be considered as obvious to arrive at the present invention directly from the teachings of the references, but instead the teachings of the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in claim 9. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not disclose anything which would lead to a person of ordinary skill in the art to the present invention as defined in claim 9, and therefore the obviousness rejection under 35 U.S.C. 103(a) should also be considered as not tenable and should also be withdrawn.

It should be further mentioned that the references not only did not disclose the new features of the present invention, but they actually teach away from the basic idea of the present invention.

While the percussion mechanism in accordance with the present invention has a blocking element which blocks the striker in its forward motion, in the corresponding mechanisms in the references in the blocking elements do not block the forward motion of the striker, because they are configured in an different way. As defined in *re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994):

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, upon reading the reference...would be led in a direction diverging from the path that was taken by the applicant".

It is believed that this decision is clearly applicable for the comparison between the present invention and the solutions proposed in the *Meutchele* and *Frauhammer* references, which clearly teach away from the basic idea of the present invention as now defined in claim 9.

Finally, the patent to Frauhammer can not be considered as a valid reference, because its issue date is later than the filing date of the PCT application, based on which the present application has been filed.

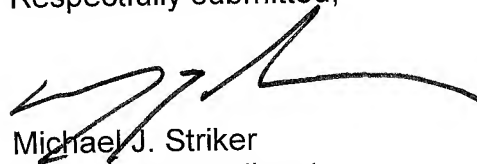
Claim 9 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 9, they share its allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', written over the printed name.

Michael J. Striker
Attorney for Applicant
Reg. No. 27233